

REMARKS

The pending claims are 23-48. Claims 23, 38, 41 and 43 are amended herein to correct informalities and to better claim that which the inventor regards as his invention. In response to the Examiner's objection in the Final Office Action to the term "optionally" in claims 38 and 41, Applicant requests entry of new dependent claims 49-52. Applicant recognizes that in general new claims may not be entered as a matter of right after final rejection, but respectfully notes that these amendments should place the claims in condition for allowance, do not raise new substantive issues or touch the merits of the application, and should require only a cursory review by the Examiner. With respect to a showing under 37 C.F.R. §116(c), should the Examiner deem this required, Applicant notes that these amendments were necessitated by the rejection of claims 38 and 41 under 35 U.S.C. §112, ¶2, in the previous Office Action. Care has been taken to not introduce any new matter and entry of the amendments is requested.

Review and reconsideration of the Office Action of June 6, 2003 is respectfully requested in view of the above amendments and the following remarks.

I. Preliminary Matters

A. Allowed and Allowable Claims

The Examiner's allowance of claims 28-30, 34, 41 and 47, and his finding that claims 26, 27, 38-46 and 48 would be allowable if rewritten or amended to overcome the rejections

under 35 U.S.C. §112, and to include all of the limitations of the base claim and any intervening claims, is gratefully acknowledged.

B. Claim For Foreign Priority Under 35 U.S.C. §119

Applicant notes that the Examiner has not yet acknowledged on the Office Action Summary page the claim of the present application for priority from EP Application No. 991111000.6, filed June 19, 2000. The Examiner is respectfully requested to clarify in the next communication whether or not he has yet received a certified copy of the priority document from the International Bureau.

II. Rejections of the Claims

A. Claim Rejections under 35 U.S.C. §112, ¶2

Claims 23-27, 31-33, 35-46 and 48 stand rejected under 35 U.S.C. §112, ¶2 as being allegedly indefinite.

With respect to claim 23, this claim is amended herein in accord with both of the Examiner's suggestions. First, "space" is amended to --spaced--. Second, the claim is amended to recite "at least two treating elements." This amendment finds support at, for example, paragraph 00029 of the specification.

With respect to claim 38, the Examiner first objects to the use of the term "optionally" as applied to a guide wire and a second lumen. Claim 38 is amended herein to delete the reference to an optional guide wire and an optional second lumen. New dependent claims 49 and 50 are added directed to these embodiments, which find support, for example, at paragraph

00018 of the specification. Second, as discussed above with reference to claim 23, claim 38 is also amended herein to recite "at least two treating elements." Third, "space" is amended to --spaced-- in accord with the Examiner's suggestion.

With respect to claim 41, the use of the term "optionally" as applied to a guide wire and a second lumen is again objected to. Claim 41 is amended herein to delete reference to an optional guide wire and an optional second lumen. New dependent claims 51 and 52 are added directed to these embodiments, which find support, for example, at paragraph 00018 of the specification.

With respect to claim 43, the relationship between the treatment elements and the deflection site is allegedly indefinite. Claim 43 is amended herein to recite "at least two treating elements" and to correct a typographical error in the word "preferably." Applicant asserts that, as amended, claim 43 is not indefinite because the relationship between the treatment elements and the deflection site is set forth in section (b).

In view of the above amendments, Applicant respectfully requests that the rejection of claims 23-27, 31-33, 35-46 and 48 under 35 U.S.C. §112, ¶2, be withdrawn.

B. Claim Rejections under 35 U.S.C. §102

Claims 23-25, 31 and 35-37 stand rejected as being allegedly anticipated by Langton (U.S. Patent 5,460,592). The Examiner appears to be taking element (15) as the container and element (14) as the seeds.

Langton teaches a carrier assembly for the delivery of spaced radioactive seeds encased in a bio-absorbable material.

The carrier assembly is heat-treated to become substantially rigid or non-deflecting (column 6, lines 48-49). In fact, the whole thrust of the teaching of Langton is towards producing radioactive seeds in an elongated material that is "sufficiently rigid as to be 'non-deflecting'" (column 1, lines 44-46) so that the seeds may be pushed into the target tissue, rather than being pulled, as in the prior art cited (see column 1 generally).

Applicant respectfully traverses the rejection on the grounds that Langton fails to teach every element of claim 23 and therefore cannot anticipate it. Further, Langton cannot anticipate claims 23-25, 31, and 35-37, because all of these claims depend from claim 23.

Specifically, Applicant asserts that Langton nowhere teaches or suggests the element of a container having at least one deflection site. To the contrary, Langton teaches the desirability of producing a non-deflecting casing and a method for making the same. In teaching a semi-rigid casing, Langton also fails to teach that at least one deflection site is located in the space between two treating elements. Because Langton fails to teach at least these elements of claim 23, it cannot anticipate the claim.

With respect to dependent claim 24, Applicant respectfully notes that the product of the teaching of Langton, following heat treatment and cooling of the bio-absorbable material, is not a hollow cylinder, as recited in claim 24 of the instant application. To the contrary, as depicted in Langton at Figs. 7, 10, and 13, and as described at column 2, line 56 to column 3, line 13, heat treatment produces shrinkage that is depicted

as resulting in an closed structure rather than a hollow cylinder.

With respect to dependent claim 25, the heat-treated container taught by Langton is not a highly flexible material, as required by claim 25.

With respect to dependent claim 35, Langton teaches that the container, which the Examiner identifies as numeral 15, is a bio-absorbable carrier material (col. 4, lines 63-64). Exemplary materials are provided at column 5, lines 22-38. Nowhere does Langton teach a metallic capsule.

Therefore, in view of the above-mentioned differences between the instantly claimed invention and the teaching of Langton, and in view of the failure of Langton to teach or suggest all of the elements of the rejected claims, Applicant respectfully requests that the rejection of claims 23-25, 31 and 35-37 under 35 U.S.C. §102 be withdrawn.

C. Claim Rejections under 35 U.S.C. §103

Claims 32 and 33 stand rejected as being allegedly unpatentable for obviousness over Langton in view of official notice taken by the Examiner that "the use of spacers and the shape of the spacers are well known in the medical arts." It appears to be the Examiner's position that it would have been obvious to one of the ordinary skill in the art at the time the invention was made to combine such spacers with the seeds taught by Langton to adapt the radiation dose for each patient.

Applicant respectfully traverses the rejection.

Applicants asserts, for reasons given above, that Langton

does not teach all of the elements of claims 32 and 33 because it does not teach all of the elements of claim 23, from which the rejected claims properly depend, and that the Examiner's official notice of the use of spacers does not remedy this deficiency.

Therefore, Applicants assert that the combination of Langton and the alleged facts of which the Examiner takes official notice is insufficient to arrive at the invention as claimed in claims 32 and 33.

Applicant further asserts that the modification of Langton that the Examiner proposes, to provide the "elongated container having at least one deflection site" of claims 32 and 33, is impermissible because Langton explicitly teaches the desirability of the use of a non-deflecting material for the container and therefore teaches away from the present invention. Applicant notes that it is improper to modify the teaching of a reference so as to render the prior art unsatisfactory for its purpose or change the principle of operation of a reference. MPEP 2143.01. Langton teaches the use of radioactive seeds in an elongated material that is "sufficiently rigid as to be 'non-deflecting'" (column 1, lines 44-46) so that the seeds may be pushed into the target tissue. The Examiner's proposed modification - the introduction of at least one deflection site - would render the teaching of Langton unsuitable for its stated purpose as being no longer capable of being pushed into a target tissue.

Therefore, in view of the above remarks, Applicant respectfully requests that the rejection of claims 32 and 33

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under 35 U.S.C. §103(a) be withdrawn.

As no further issues remain in this case, early issuance of the Notice of Allowance is respectfully requested.

Respectfully submitted,

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CERTIFICATE OF MAILING AND AUTHORIZATION TO CHARGE

I hereby certify that a copy of the foregoing AMENDMENT A for U.S. Application No. 10/018,623 filed December 18, 2001, was deposited in first class U.S. mail, postage prepaid, addressed: Mail Stop: AF, Commissioner for Patents, P.O. Box 1450. Alexandria, VA 22313-1450, on this 3rd day of September, 2003.

The Commissioner is hereby authorized to charge any additional fees that may be required at any time during the prosecution of this application, except for the issue fee, without specific authorization, or credit any overpayment, to Deposit Account No. 16-0877.

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